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EXAMINER

CHUNG, JASON J

ART UNIT

PAPER NUMBER

2611

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18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/257,209

Applicant(s)

OCHIAI, KATSUHIRO

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-10, 28, 29 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 28, 29 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The examiner had two grounds of rejection for the claims in the Non-Final Office Action mailed on 9/12/03. The applicant argues on page 13, second paragraph of the response that Ito discloses finding a vacant area when recording corresponds to finding a vacant area in a single recording apparatus and is not directed to finding an available apparatus among a plurality of apparatuses. The examiner respectfully agrees with this assertion. The examiner has withdrawn rejection of Ito. However the examiner maintains the grounds of rejection using Iwamura in view of Van Steenbrugge with respect to claims 7-10, 28-29. The amendments to claims 1, 3, and 35-38 (which depend on 1 and 3) necessitate new grounds of rejection with respect to claims 1, 3 and 35-38 (which depend on 1 and 3).

Applicant's arguments filed 1/7/04 have been fully considered but they are not persuasive. The applicant states in the third paragraph on page 12-page 15 of the response that the requesting video apparatus is the one that makes decisions as to which of a plurality of other video apparatuses to utilize as a communication partner and the network management apparatus of the claimed (claim 1) invention merely collects state information provided by the video apparatuses and supplies the collected state information to a requesting one of the video apparatuses whereas Ito is different. The examiner takes a broader read of the claimed invention.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., requesting video apparatus is the one that makes decisions as to which of a plurality of other video apparatuses to utilize as a communication partner and the network management apparatus of the

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claimed invention merely collects state information provided by the video apparatuses and supplies the collected state information to a requesting one of the video apparatuses) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the current claim and none of the other independent claims precludes the network management apparatus making decisions about which video apparatuses to be communication partners. Additionally, the current claim and none of the other independent claims precludes the network management apparatus and the video apparatuses working together to determine communication partners. The claim is broad enough to read on both of these interpretations. The applicant argues the same issue with respect to the reference of Iwamura on page 15-17. The examiner respectfully disagrees with this assertion and applies the same reasoning as the reasoning used to Ito.

The applicant states in the second paragraph on page 12 of the response that Ito discloses the recording/reproducing device 26 identifies the an available region for which video and audio data is to be recorded and that information is provided to the data I/O device 10 that initially made the request to the recording/reproducing control circuit 34.

The applicant argues on pages 13-14 of the response that claims 3, 29 are much different than claim 1. The examiner would like to point out that claim 9 is also the similar to claims 3 and 29. Claims 3, 9, and 29 are broader than claim 1. Claims 9 and 29 are rejected under section 102 as stated below. Claim 3 contains an additional limitation based on a request output by the one of the video apparatuses, which is why claim 3 is rejected under section 103.

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The applicant argues on page 15 with regard to claims 35 and 37 that the network management apparatus does not make this determination. This is not in the claim.

Accordingly, the examiner has presented a new ground of rejection as stated below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "at least one of" in line 10. Claim 39 does not recite at least one of" in line 12. There is insufficient antecedent basis for this limitation in the claim 39.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7, 8, 10, 28, 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (US Patent # 5,883,621) in view of Ito (US Patent # 6,085,019).

Regarding claim 1, Iwamura discloses an IEEE 1394 serial bus standard (column 2, lines 5-7), which meets the limitation on network.

Iwamura discloses an IRD (network management apparatus) comprises of PHY 224 that initializes the bus (column 4, lines 55-67), which meets the limitation on a network management apparatus.

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Iwamura discloses a DVD player 900, mini disc player 902, and digital VCRs 903, 904 (figure 10), which meets the limitation on plural types of video apparatuses connected to the network. Iwamura discloses a topology map that can be generated by a receiver or by a TV set (column 3, lines 24-29), which is the network management apparatus connected to a network.

The examiner notes the claim is worded in such a way where **only one of** the following limitations must be met: function, application program interfaces, service-availability, stored programs. Iwamura discloses the self ID stores the connection status in the RAM 304 of IRD 100 (network management apparatus) (column 5, lines 25-44; figure 2a). Iwamura discloses the self identification process is performed with the DSS IRD 100 and the devices are given nodes and automatically assigned device names and the DSS IRD constructs a map in the CPU 312 of IRD (column 5, line 45-column 6, line 5); the device sending the self ID packet is the device telling the network that they have just joined, which meets the limitation on the plural types of video apparatus transmit the state relating to the service availability and application program interfaces. Iwamura discloses the user uses a drag and drop method for recording and figure 12 illustrates the signal flow information (column 8, lines 57-65), which meets the limitation on inquiring about the state of other video apparatuses and determining a communication partner based on information of the states of other video apparatuses which are obtained from the network management apparatus.

Iwamura fails to disclose the video apparatuses being capable of inquiring about state information of other of the video apparatuses **by sending an inquiry to the network management apparatus.**

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Ito discloses a control bus 20 and a data bus 22 (column 5, lines 45-61); the combination of the data bus and control bus reads on a network. Ito discloses the recording/reproducing control circuit 34 (network management apparatus) searches for an empty or available recording region (column 7, lines 25-37). Ito discloses when it is desired to record a signal on the recording/reproducing device 26, an external device supplies a record request signal to the recording/reproducing control circuit 34 (network management apparatus) (column 7, lines 15-25). Ito discloses the recording/reproduction device 26 sends the reproduction request signal to the recording/reproducing control circuit 34 via I/O device (column 8, lines 10-28). Ito discloses the recording/reproducing control circuit has a memory, which contains an index or table of content (column 7, lines 31-37). Ito discloses during recording or reproducing, recording/reproducing control circuit 34 interfaces the recording/reproducing device to send signals to the external device (column 6, line 65-column 7, line 14). Ito discloses the recording reproducing control apparatus searches for an empty or available recording region (column 7, lines 15-53), which meets the limitation on the video apparatus being capable of inquiring about state information of other video apparatuses by sending an inquiry to the network management apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iwamura to have the video apparatus inquire about another video apparatus based on state information provided by the network management apparatus as taught by Ito in order to give the user less unnecessary trouble with decision making on signal paths.

Regarding claim 2, Iwamura discloses a plurality of the same digital VCR's 903, 904 connected to a network (figure 10).

Regarding claim 3, the limitations in claim 3 have been met in claim 1 rejection.

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Regarding claim 4, the limitations in claim 4 have been met in claim 2 rejection.

Regarding claim 7, the limitations in claim 7 have been met in claim 1 rejection.

Regarding claim 8, the limitations in claim 8 have been met in claim 2 rejection.

Regarding claim 10, the limitations in claim 10 have been met in claim 2 rejection.

Regarding claim 28, the limitations in claim 28 have been met in claim 1 rejection.

Regarding claims 35-36, Ito discloses the recording reproducing control apparatus searches for an empty or available recording region (column 7, lines 15-31), which meets the limitation on the communication partner is automatically selected by one of the video apparatuses concerning currently available resources and the video apparatuses do not include resources that are currently assigned to any video apparatuses.

Regarding claims 37-38, the limitations in claims 37-38 have been met in claims 35-36 rejections.

4. Claims 7-10, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (US Patent # 5,883,621) in view of Van Steenbrugge (US Patent # 5,054,022).

Regarding claim 7, Iwamura discloses an IEEE 1394 serial bus standard (column 2, lines 5-7), which meets the limitation on network.

Iwamura discloses an IRD (network management apparatus) comprises of PHY 224 that initializes the bus (column 4, lines 55-67), which meets the limitation on a network management apparatus.

Iwamura discloses a DVD player 900, mini disc player 902, and digital VCRs 903, 904 (figure 10), which meets the limitation on plural types of video apparatuses connected to the

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network. Iwamura discloses a topology map that can be generated by a receiver or by a TV set (column 3, lines 24-29), which is the network management apparatus connected to a network.

The examiner notes the claim is worded in such a way where **only one of** the following limitations must be met: function, application program interfaces, service-availability, stored programs. Iwamura discloses the self identification process is performed with the DSS IRD 100 and the devices are given nodes and automatically assigned device names and the DSS IRD constructs a map in the CPU 312 of IRD (column 5, line 45-column 6, line 5), which meets the limitation on the plural types of video apparatus transmit the state relating to the application program interfaces and service availability. Iwamura discloses the user uses a drag and drop method for recording and figure 12 illustrates the signal flow information (column 8, lines 57-65), which meets the limitation on inquiring about the state of other video apparatuses and determining a communication partner based on information of the states of other video apparatuses which are obtained from the network management apparatus.

Iwamura fails to disclose the operation is performed without user input or automatically. Van Steenbrugge discloses automatic (without any user input) priority system for signal paths so that the user is not unnecessarily troubled with decision-making on signal paths to established and signal paths to be canceled (column 2, lines 15-28). Van Steenbrugge discloses videocassette recorders 42, 44, compact disc video players 46,58, video monitors 54, 56, TV apparatus 42; each of the devices has a control device (column 4, lines 60-68 and column 5, lines 1-9). Van Steenbrugge discloses the control devices are attached to a single path control bus 60 (column 5, lines 10-18; figure 2). Van Steenbrugge discloses the signal interconnection commands Connect and Select are used which may be connected to another switchbox subdevice

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or it may be connected via one or more switchboxes in between (column 6, lines 63-68 and column 7, lines 1-8). Van Steenbrugge discloses the connected to switchbox request and connected to switchbox request investigates (a video apparatus to be a communication partner) the other subdevice and plug on the subdevice it has current signal interconnections (on the basis of other states) (column 7, lines 35-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iwamura to have communication without user input as taught by Van Steenbrugge in order to give the user less unnecessary trouble with decision making on signal paths.

Regarding claim 8, Iwamura discloses a plurality of the same digital VCR's 903, 904 connected to a network (figure 10).

Regarding claim 9, the limitations in claim 9 have been met in claim 7 rejection.

Regarding claim 10, the limitations in claim 10 have been met in claim 8 rejection.

Regarding claims 28-29, the limitations in claims 28-29 have been met in claim 7 rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura.

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Regarding claim 29, Iwamura discloses IRD 905, DVD player 900, mini disc player 902, and digital VCRs 903, 904 (figure 10), which meets the limitation on a broadcast receiving component for receiving a broadcast program and broadcast storing components for storing broadcast programs. Iwamura discloses a topology map that can be generated by a receiver or by a TV set (column 3, lines 24-29).

Iwamura discloses an IEEE 1394 serial bus standard (column 2, lines 5-7), which meets the limitation on network. Iwamura discloses an IRD comprises of PHY 224 that initializes the bus (column 4, lines 25-67), which meets the limitation on a network for connecting the broadcast receiving component and the broadcast storing components.

The examiner notes the claim is worded in such a way where **only one of** the following limitations must be met: function, application program interfaces, service-availability, stored programs. Iwamura discloses the self ID stores the connection status in the RAM 304 of IRD 100 (network management apparatus) (column 5, lines 25-44; figure 2a). Iwamura discloses the self identification process is performed with the DSS IRD 100 and the devices are given nodes and automatically assigned device names and the DSS IRD constructs a map in the CPU 312 of IRD (column 5, line 25-column 6, line 5); the device sending the self ID packet is the device telling the network that they have just joined, which meets the limitation on the plural types of video apparatus transmit the state relating to the service availability. Iwamura discloses the user uses a drag and drop method for recording and figure 12 illustrates the signal flow information (column 8, lines 18-32 and column 8, lines 57-65), which meets the limitation on obtained from the broadcast storing components through the network.

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Regarding claim 9, the limitations in claim 9 have been met in claim 29 rejection.

Iwamura discloses the user uses a drag and drop method for recording and figure 12 illustrates the signal flow information (column 8, lines 18-32 and column 8, lines 57-65), which meets the additional limitation on means for inquiring about the state information of other video apparatuses to the other video apparatuses and then determining a video apparatus to be a communication partner on the basis of the state information of the other video apparatus which are obtained from the other video apparatuses.

Allowable Subject Matter

6. Claims 39-40 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. To overcome the rejection under section 112, the examiner respectfully requests the applicant to delete the phrase, "at least one of" in each of the respective independent claims that claims 39-40 depend on.

Regarding claim 39, Iwamura discloses when a new device is added, there is a bus initialization, self identification, and device identification (column 4, line 25-column 5, line 5); the newly connected device notifying the network of a new connection meets the limitation on service availability, the device identification meets the limitation on functions, which meets the limitation on when another video apparatus is newly connected to the network, the another video apparatus outputs on the network, without first being requested to do so by any other apparatus, information concerning the functions and service availability. Iwamura fails to disclose stored programs of another video apparatus.

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Iwamura discloses the user uses a drag and drop method for recording and figure 12 illustrates the signal flow information (column 8, lines 18-32 and column 8, lines 57-65), which would require one device requesting program information from another device and therefore does not meet the limitation on **without first being requested to do so by any other apparatus**. Ito discloses the recording/reproducing control circuit 34 (network management apparatus) searches for an empty or available recording region (column 7, lines 25-37). Ito discloses when it is desired to record a signal on the recording/reproducing device 26, an external device supplies a record request signal to the recording/reproducing control circuit 34 (network management apparatus) (column 7, lines 15-25). Ito discloses the recording/reproduction device 26 sends the reproduction request signal to the recording/reproducing control circuit 34 via I/O device (column 8, lines 10-28). Ito discloses the recording/reproducing control circuit has a memory, which contains an index or table of content (column 7, lines 31-37). Ito discloses during recording or reproducing, recording/reproducing control circuit 34 interfaces the recording/reproducing device to send signals to the external device (column 6, line 65-column 7, line 14). Ito discloses the recording reproducing control apparatus searches for an empty or available recording region (column 7, lines 15-31), which requires one device requesting program information from another device and therefore does not meet the limitation on **without first being requested to do so by any other apparatus**. Neither Iwamura, Ito, nor any other references searched discloses without first being requested to do so by any other apparatus, information concerning the stored programs of the another video apparatus.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC



**VIVEK SRIVASTAVA
PRIMARY EXAMINER**